

Serial No. 10/706,437  
Page 4

### REMARKS

In the Office Action dated November 18, 2005, the Examiner acknowledges the cancellation of Claims 13-19, but it appears that these claims (13-19) are mistakenly included under new claim rejections -35 USC § 103. The present response is directed to the rejections of only claims 1-12 under 35 USC § 103(a) as requested by the Examiner on page 8 of the Office Action. Presently, claims 1-12 are pending in the application. No Claim stands allowed. Claims 1, 2, 4, and 6 have been amended to correct informalities thereof.

Favorable reconsideration and allowance are requested in light of the foregoing remarks which follow.

**1. Rejection of claims 1 - 3, 6, 9 -12 under 35 USC § 103(a) as being unpatentable over Kiang (U.S. Patent No. 5,370,941).**

The Office Action rejects claims 1 - 3, 6, 9 - 12 under 35 USC § 103(a) as being unpatentable over Kiang (U.S. Patent No. 5,370,941). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Indeed, both the suggestion and the expectation of success must be found in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1988) (emphasis added). The Applicant believes that the Examiner has failed to make a *prima facie* case of obviousness.

Serial No. 10/706,437  
Page 5

The Examiner contends that Kiang discloses a food contact release layer comprising polymethylpentene which the polymethylpentene comprises a polymethylpentene homopolymer (column 7, lines 49-42) and that the copolymer is a copolymer of polyethylpentene with propylene (column 6, lines 29-35) and is therefore a polypropylene. The Examiner admits that "Kiang fails to disclose a food contact release layer comprising a blend of polymethylpentene and polypropylene. However, it would have been obvious for one ordinary skill in the art to have selected a polymethylpentene homopolymer or copolymer or a blend of a polymethylpentene homopolymer and copolymer, since it has been to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice."

Applicants respectfully take exception to the Examiner's characterization of the disclosure of Kiang. First, the independent claim 1 recites an ovenable laminate comprising a paperboard substrate and a food contact release layer that bonded to one side of the substrate. The food contact release layer comprises a blend of polymethylpentene and propylene. Contrariwise, Kiang discloses a laminate wherein the substrate contains a layer of only PMP as the food contact surface. The Applicants asserts that Kiang discloses a blend of a homopolymer of polymethylpentene and a copolymer, the latter consisting of two monomers, namely, 1-methylpentene and propylene. Kiang then teaches that such blend is an adhesive for adhering polymethylpentene to an EVOH layer. (Column 6, lines 23 et seq.). This teaching, in fact, has no material relationship to a "food release layer" comprising a blend of polymethylpentene and propylene as recited in the claim 1 of the present invention.

Serial No. 10/706,437  
Page 6

Moreover, the surface tension of a blend of a homopolymer of polymethylpentene and a copolymer consisting of two monomers, namely, 1-methylpentene and propylene, as taught by Kiang, would readily be recognized by one skilled in the art as being materially different from the surface tension claimed by the Applicants, this being a consequence of the different materials which make up the Kiang adhesive blend and the materials which make up the food contact release layer recited in the claim 1 of the present invention. As noted by the Examiner, Kiang fail to disclose that the "food contact layer comprises a blend of about 75% by weight of the blend of polymethylpentene with the remainder being polypropylene, as recited in claim 2 of the present invention. Most importantly Kiang fails to disclose a blend which is a "food contact release" layer. Rather, Kiang teaches one skilled in the art that PMP needs an adhesive to bond the PMP to EVOH or the like, the PMP itself being the food contact release layer. Contrariwise, Applicants' claimed invention, the food contact layer is a blend.

The Applicants assert that it is important to consider how one skilled in the art would read Kiang and would be motivated to make modifications as defined and recited in the claim 1 of the present invention. For instance, Kiang at column 7, lines 7-19 states: "In a particularly useful embodiment of the invention, a five-layer coextrusion is applied to paperboard. The five-layer coating coextruded onto the paperboard has a PMP layer in contact with the paperboard, an interlayer of the adhesive blend, an EVOH barrier layer, another interlayer of adhesive blend, and a final layer of PMP. Such constructions are graphically depicted paperboard/PMP/tie/EVOH/tie/PMP. The exterior PMP layer imparts food grease and oil resistance to these constructions and also exhibits superior food release properties rendering such laminates highly useful for the construction of formed ovenable food containers. Clearly, in the Kiang patent, the

Serial No. 10/706,437

Page 7

motivation is to a blend of a homopolymer of polymethylpentene and a copolymer which such blend is an adhesive for adhering polymethylpentene to an EVOH layer. Therefore, Kiang does not provide an apparent basis for concluding a person of ordinary skill in the art would be motivated to modify the cited reference so as to arrive at the claimed invention with a reasonable expectation of success in achieving the advantages of the claimed invention. Therefore, this rejection is inappropriate and should be withdrawn. Thus, the independent claim 1 defines a patentable subject matter and each of claims 2-12 is dependent, either directly or indirectly upon claim 1 and therefore inherits each and every element of their parent claim and any intervening claim(s). Allowance of these dependent claims is urged for the same reasons, among others, as set forth hereinabove in discussing claim 1.

Claim 4 is rejected under 35 USC § 103(a) as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Lorence (U.S. Patent No. 5,818,016). Claim 4 is directly dependent on claim 1. The inapplicability of Kiang to the patentability of Claim 1 is noted hereinabove and attention is invited to such discussions. Particularly, the failure of Kiang as the primary reference in a combination of Kiang with Lorence is respectfully submitted to be inappropriate in view of the failure of Kiang to teach, suggest or disclose a "food contact release layer comprising a blend of polymethylpentene and polypropylene bonded to one side of said substrate".

Thus, irrespective of what Lorence teaches with respect to a paperboard substrate suitable for use in combination with the teachings of Kiang, the failure of Kiang as a primary reference negates the combination of Kiang and Lorence as a basis for rejection of claim 4 of the present application.

Serial No. 10/706,437  
Page 8

Withdrawal of the rejection of claim 4 as being unpatentable under 35 USC §103(a) over Kiang in view of Lorence is respectfully requested.

Claim 5 is rejected under 35 USC § 103(a) as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Shanton (U.S. Patent No. 6,066,375). Claim 5 is directly dependent on claim 1. Again, the Examiner cites Kiang as disclosing "a laminate comprising paperboard as discussed above", with Shanton being cited as teaching "a paperboard laminate having a paperboard with a basis weight of between 18 and 320 lbs/3000 ft<sup>2</sup>. Claim 5 is directly dependent on claim 1. The inapplicability of Kiang to the patentability of claim 1 is noted hereinabove and attention is invited to such discussions. As noted above, particularly, the failure of Kiang as the primary reference in a combination of Kiang with Lorence is respectfully submitted to be inappropriate in view of the failure of Kiang to teach, suggest or disclose a "food contact release layer comprising a blend of polymethylpentene and polypropylene bonded to one side of said substrate".

Thus, irrespective of what Shanton teaches with respect to a paperboard substrate suitable for use in combination with the teachings of Kiang, the failure of Kiang as a primary reference negates the propriety of combining Kiang and Shanton as a basis for rejection of claim 5 of the present invention.

Withdrawal of the rejection of claim 5 as being unpatentable under 35 USC §103(a) over Kiang in view of Shanton is respectfully requested.

Claim 7 is rejected under 35 USC § 103(a) as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Bissot (U.S. Patent No. 4,818,782). Claim 7 is indirectly dependent on claim 1. Similarly, the Examiner cites Kiang as disclosing "a paperboard laminate having a tie

Serial No. 10/706,437

Page 9

layer between a grease resistant layer comprising ethylene vinyl alcohol and a food contact layer as discussed above", with Bissot being cited as teaching "low density polyethylene modified with methacrylic acid is used interchangeably with other modified polyolefins as adhesive between ethylene". The inapplicability of Kiang to the patentability of claim 1 is noted hereinabove and attention is invited to such discussions. As noted above, particularly, the failure of Kiang as the primary reference in a combination of Kiang with Shanton is respectfully submitted to be inappropriate in view of the failure of Kiang to teach, suggest or disclose a "food contact release layer comprising a blend of polymethylpentene and polypropylene bonded to one side of said substrate".

Thus, irrespective of what Shanton teaches with respect to a paperboard substrate suitable for use in combination with the teachings of Kiang, the failure of Kiang as a primary reference negates the propriety of combining Kiang and Shanton as a basis for rejection of claim 7 of the present invention.

Withdrawal of the rejection of claim 7 as being unpatentable under 35 USC § 103(a) over Kiang in view of Shanton is respectfully requested.

Claim 8 is rejected under 35 USC § 103(a) as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Adur (U.S. Patent No. 5,942,295). Claim 8 is indirectly dependent on claim 1. As noted above, the Examiner cites Kiang as disclosing "a paperboard laminate having a tie layer as discussed above", with Adur being cited as teaching "a tie layer having a coat weight of 1 lb/3000ft<sup>2</sup> in a paperboard laminate". The inapplicability of Kiang to the patentability of claim 1 is noted hereinabove and attention is invited to such discussions. As noted above, particularly, the failure of Kiang as the primary reference in a combination of Kiang with Adur is

Serial No. 10/706,437  
Page 10

respectfully submitted to be inappropriate in view of the failure of Kiang to teach, suggest or disclose a "food contact release layer comprising a blend of polymethylpentene and polypropylene bonded to one side of said substrate".

Thus, irrespective of what Adur teaches with respect to a paperboard substrate suitable for use in combination with the teachings of Kiang, the failure of Kiang as a primary reference negates the propriety of combining Kiang and Adur as a basis for rejection of claim 8 of the present invention.

Withdrawal of the rejection of claim 8 as being unpatentable under 35 USC §103(a) over Kiang in view of Adur is respectfully requested.

### CONCLUSION

Therefore, Applicants respectfully submit that the independent claim 1 particularly define and patentably distinguish the present invention over the cited references. In addition, all of the dependent claims which depend from claim 1 also define a patentable subject matter.

Accordingly, reconsideration of the rejections and allowance of claims 1-12 is earnestly requested. However, should the Examiner have any remaining questions and the attending to of which would expedite such action, the Examiner is invited to contact the undersigned at the telephone number listed below.

Serial No. 10/706,437  
Page 11

The Commissioner is authorized to charge any fees associated with this or any other communication, or credit any over payment, to Deposit Account No. 09-0525.

Respectfully submitted,

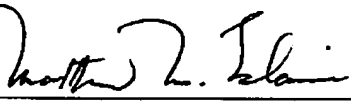
Victor Paul Holbert, Applicant

David Verd Reed, Applicant

Christopher S. Cleveland, Applicant

James Irvin Marchman, Applicant

Date: February 17, 2006

By: 

Matthew M. Eslami

Reg. No. 45,488

Patent Agent for Applicant

International Paper Company

6285 Tri-Ridge Boulevard

Loveland, Ohio 45140

Tel: (513) 248-6193

Fax: (513) 248-6455

e-mail: matt.eslami@ipaper.com